

REMARKS

Upon entry of the present amendment, Claims 1-22 are pending in the application; of amended Claims which claims 1, 8, 14 and 18 are independent.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted. It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

The applicant also wishes to thank the Examiner for his courtesy and consideration in granting the interview which took place on February 3, 2005. Applicant believes that the interview was productive, and helped to clarify the differences between the present invention and the prior art.

After careful consideration of the objections and rejections set forth in the Office Action, applicant respectfully submits that as presently amended, each of claims 1-22 patentably distinguishes over the art of record, and requests allowance of all pending claims, as discussed further below.

Section 112 Issues

In the above-identified Office Action, the Examiner rejected claims 14-17 under 35 USC 112, second paragraph, as indefinite. The Examiner objected to these method claims being dependent from an apparatus claim.

Applicant has amended claim 14 to be in independent form, and claim 14 is now in full compliance with the requirements of 35 USC 112.

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35 USC 103 issues

In item 3 of the above-identified Office Action, the Examiner rejected claims 1, 3-8, 10 and 14 and 17 under 35 USC 103 (a) as unpatentable over Weller or Dugan, each in view of Tregear or Vail. The Examiner stated that Weller and Dugan each disclose gutter inserts having surfaces contacting three walls of the gutter, and having a water flow path between the insert and the gutter, substantially as claimed, and indicated that Tregear and Vail each provide a gutter screen of a synthetic fibrous material with a foraminous plastic screen on top, and inserted below a gutter lip.

Applicant encloses herewith a Declaration of Brian Groth, along with an accompanying comparative material flow report done by an independent test facility. This flow report substantially replicates the demonstration that applicant showed the Examiner, in which applicant's commercial embodiment, including a nonwoven mat comprising a plurality of filaments having open interstices defined therebetween, with a binder affixing selected areas of the filaments to one another, exhibited markedly superior flow rates, as compared to, and contrasted with polyurethane foam and spun polyester material.

Applicant respectfully suggests that the Declaration and accompanying report clearly establish that polyurethane foam and applicant's aggregate filter material are not equivalent materials, and are not interchangeable. Therefore, applicant respectfully suggests that any rejection of applicant's claims based in part on Weller or Dugan has been overcome by this showing.

Regarding the Tregear and Vail references, each of these references teach a respective filter apparatus which is markedly different from applicant's claimed filter. Neither Tregear nor Vail includes an insert body as claimed which substantially fills a portion of the gutter. Neither

Tregear nor Vail includes an insert body which contacts the floor of the gutter. Neither Tregear nor Vail includes an insert body in which the arrangement of filaments within the nonwoven mat defines a substantially flattened top surface thereof.

Applicant has amended claims 1, 8 and 14 to specify that the arrangement of filaments within the nonwoven mat of the insert body defines a substantially flattened top surface thereof.

Applicant suggests that this further distinguishes applicant's claimed invention over all known prior art.

Applicant therefore requests reconsideration and withdrawal of the rejection of claims 1, 3-8, 10-14 and 17 under 35 USC 103 (a) as unpatentable over Weller or Dugan, each in view of Tregear or Vail.

In item 4 of the Office Action, the Examiner rejected claims 2 and 9 under 35 USC 103(a) as unpatentable over Weller or Dugan, each in view of Tregear or Vail as applied in item 3, and further in view of Chinn.

As previously noted, applicant submits that the enclosed Declaration of Brian Groth overcomes any rejection based on Weller or Dugan. The teachings of Tregear and Vail are discussed above in connection with item 3 of the Office Action.

The Chinn reference teaches an environmental filter for installation in a catch basin grate, as well as a roll filter for installation covering a street curb drain. While Chinn does teach the use of coconut fibers as part of a composite filter roll, a reference must be considered as a whole. Chinn only teaches coconut fiber sewn between ultraviolet polypropylene mesh, rolled into a cylinder, and inserted into a robe of geotextile material. Chinn fails to teach, disclose or suggest a gutter insert, for use with a rain gutter, of the type claimed by applicant. Applicant respectfully suggests that the Chinn reference does not make applicant's claimed invention obvious,

reconsidered either separately or in any reasonable combination with other references.

Therefore, applicant respectfully suggests that the new amendments to the claims patentably distinguish over the teaching of all references of record, and applicant requests reconsideration and withdrawal of the Examiner's rejection of claims 2 and 9 under 35 USC 103(a) as unpatentable over Weller or Dugan, each in view of Trcgear or Vail as applied in item 3, and further in view of Chinn.

In item 5 of the Office Action, the Examiner rejected claim 16 under 35 USC 103(a) as unpatentable over the references as applied to claim 14, and further in view of Hunt.

Applicant suggests that the amendments to the claims, as well as the Declaration of Brian Groth submitted with the present amendment, overcome this ground of rejection.

Applicant therefore requests reconsideration and withdrawal of the Examiner's rejection of claim 16 under 35 USC 103(a) as unpatentable over Weller or Dugan, each in view of Trcgear or Vail as applied in item 3, and further in view of Hunt.

Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the objections and rejections set forth in the Office Action are overcome, and that as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered singly or in any reasonable combination.

Applicant requests reconsideration and withdrawal of the rejections of record, and allowance of the pending claims.


The Commissioner is hereby authorized to charge \$150.00, for one additional independent claim in excess of three and two additional claims in excess of twenty. The Commissioner is further authorized to charge any deficiency or credit any overpayment, during the entire pendency of the present application, to Deposit Account 50-0744 in the name of Carrier, Blackman & Associates, P.C. A duplicate copy of this sheet is enclosed.

If the Examiner is not fully convinced of all of the claims now in the application, applicant respectfully requests that he telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.

Favorable consideration is respectfully requested.

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February 25, 2005

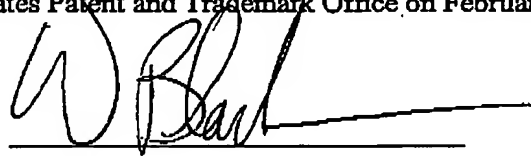
Respectfully submitted,


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to Examining Group 3617 of the United States Patent and Trademark Office on February 25, 2005, at the number (703) 872-9306.

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